SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

October Term, 1970.

No. 926

STERNER LIGHTING, INC., et al.,
Petitioners,

v.

ALLIED ELECTRICAL SUPPLY, INC., et al.,
Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit.

RESPONDENTS' BRIEF IN OPPOSITION TO WRIT OF CERTIORARI.

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THE COURT OF APPEALS DECISION.

The Court of Appeals ruled that the Guggenheim patent claims in suit are not entitled to such scope as to cover respondents' accused device and therefore are not infringed. The Opinion of the Court of Appeals is reported at 166 USPQ 454, — F. 2d —, and in Petitioners' Appendix, A-9-25.

There are no special, important, legal, or public policy interests or reasons why Petitioners' Writ should be granted.

JURISDICTION.

Jurisdictional requisites are set forth in the Petition.

QUESTIONS PRESENTED.

Petitioners' "Question" (1) and (2) are based on purported expert opinion testimony of one C. O. Grannis, contrary to the undisputed facts of the case; furthermore, as set forth below, Grannis was not qualified to testify as an infringement expert. Respondents consistently denied infringement.

Petitioners' "Question" (3) assertion that the Court of Appeals should have decided the issue of infringement on literal wording of claim 11, in *vacuo*, is contrary to the decisions.

The Court of Appeals correctly ruled herein that there is no infringement, under the undisputed facts of this case, on principles well settled, and Petitioners have raised no proper issue for review by this Court.

STATEMENT.

The Guggemos patent in suit is directed to a hinged lamp-post base. Petitioners did not prove anything *sui generis* the hinging of lamp post bases, nor did Petitioners establish any new function for the structure of Guggemos patent claim 11—even if literally interpreted, over the *Calso* prior art device (physical exhibit D-45 and photo Ex. D-9a, 636a and p. 2b *infra*) wherein the pole and ballast move, in hinging the lamp post up and down, as one unit—just as in the Guggemos patent. Respondents' accused device (Ex. P-41, 619a and p. 1b *infra*) has an ordinary hinge arrangement, not disclosed in the Guggemos patent. Guggemos claim 11 is directed to a hinged base pole, with the ballast in the lower end of the pole.

ARGUMENT.

Petitioners assert that the Court of Appeals was required to apply and interpret claim 11 as that claim literally appears—word for word—an interpretation in *vacuo*, without regard to the specification of the patent which sets forth the details of petitioners' alleged invention, and without regard to the prior art (for example, the Calso device).

The Court of Appeals in the present case found respondents' argument that the Guggemos patent is invalid for obviousness "an appealing argument" (Petitioners' Appendix A-15, 166 USPQ 454, 457) but saved the claims from a ruling of invalidity (Petitioners' Appendix A-19, 166 USPQ 454, 459) stating that they cover the hinge features described in the Guggemos patent, differentiating from *Calso*, and thus, also, from defendants' accused device: "It is quite clear that this identity is not present here, given the narrow construction we must apply to the patent."

Respondents submit that the Court of Appeals was correct in interpreting and applying claim 11, not in *vacuo*, as petitioners would like, but to cover the novelty involved —the actual differences between the disclosure in the Guggemos patent specification and the prior art. As stated in *Clark v. Wright Aeronautical Corporation*, 162 F. 2d 960, 962 (2d Cir., 1947):

> "it is horn-book law that no claims are to be read in abstractu."

Thus, the Court of Appeals measured the scope of the claims as limited to the contribution made by the patentee to the advance of science and the useful arts. The precise test thus applied by the Court of Appeals (as to which petitioners complain) was applied in the recent case of *Decca, Ltd. v. United States* (quoted directly below) recently before this Court on a petition for certiorari denied by this

Court October 19, 1970; as stated in *Decca Ltd. v. United States*, 420 F. 2d 1010, 1013 (U. S. Ct. Cl., 1970, c.d. Oct. 19, 1970; 167 USPQ advance sheets, No. 5, p. II):

> "In determining the issue of patent infringement, it is well settled law that in the first instance resort must be made to the language of the patent claim. Graver Tank & Manufacturing C. v. Linde Air Products Co., 339 U. S. 605, 70 St. Ct. 854, 94 L. Ed. 1097 (1950). The literal words of the patent claim constitute, however, only the starting point in the determination of this issue. The state of the prior art and the prosecution history of the patent application in the Patent Office are also important factors which must be considered in determining the meaning of a patent claim. Graham v. John Deere Co., 383 U. S. 1, 17, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966)."

Further in point are:

> "It is well settled that a patent owner may not apply a narrow construction to his claim to avoid the prior art and then apply a broad construction to include an accused device. If the claims in suit are interpreted so as to avoid the prior art, then they cannot cover pivoted links which were old in the art, but must be restricted to the base plate, guide rods, followers and support member arrangement disclosed in the patent. Any interpretation of the claims in suit which would render them broad enough to cover accused Model 110, would render them invalid on the prior art."
>
> "'What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case.' Graver Tank & Mfg. Co., Inc., et al. v. Linde Air Products Co., 339 U. S. 605, 609, 70 S. Ct. 854, 856, 94 L. Ed. 1097. Where the

patent is found in a crowded art, the doctrine of equivalents is given a narrow range. Parmelee Pharmaceutical Company, et al. v. Zink, 8 Cir., 285 F. 2d 465. Fife was working in a crowded art. The District Court held the doctrine of equivalents did not apply, and we agree." *Fife Mfg. Co. v. Stanford Engineering Co.*, 299 F. 2d 223, 226 (7th Cir., 1962).

In *Plax Corp. v. Precision Extruders, Inc.*, 239 F. 2d 792, 795 (3rd Cir., 1957), the Court quoted with approval the rule:

> "'that a patentee's broadest claim can be no broader than his actual invention, no matter how it may be expressed or what other claims his patent may contain' (citing cases). This is a correct statement of the law."
>
> * * *
>
> "While it is a rule that the scope of the grant is measured by the claim, yet it is true, so we think, that such grant cannot be broader than the invention described in the specifications." * * * "Therefore the claims, if their validity is to be sustained, must be confined to the invention described in the specifications. When so construed, they are not infringed by defendant's process." *Texas Co. v. Globe Oil & Refining Co.*, 225 F. 2d 725, 735 (2d Cir., 1955).
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> * * *
>
> "At any rate, the fact that the claims of the Marx patent are broad enough to cover appellant's process does not establish infringement. The claims are to be read in connection with the specifications, and a patentee's broadest claim can be no broader than his actual invention." *Kemart Corp. v. Printing Arts Research Laboratories*, 201 F. 2d 624, 629 (9th Cir., 1953).

Petitioner, Guggemos, under direct examination, (519a-520a) when asked to compare the literal wording of his claim 11 and the prior art *Calso* device (p. 2b *infra*) said:

"A. Well, in claim 11 of my patent I use a ballast in the pole shaft itself as opposed to having it in a pedestal base or transformer base as you see here". Thus claim 11 in suit: "rests upon exceedingly small and quite non-technical mechanical differences in a device which was old in the art." *Graham v. John Deere Co.*, 383 U. S. 1, 36 (1966).

The use of a ballast or transformer in a pole was admittedly old in the art, and the use of a hinged pole was admittedly old in the art, in the *Calso* and other prior art devices; Petitioners' attorney stated (transcript 625):

> "We admit that the idea of a hinged base like this, somebody else had the idea before, the Kubesh patent had it, and we so admit, and we admit somebody else thought up a light pole before, and that somebody had what is called a luminaire up at the top. We admit that they had this ballast before, although it was not up in the pole, it was down in the base."

The alleged improvement in claim 11, even if literally interpreted, is a mere reversal (as in *Graham v. Deere*, *infra*) of position of the "ballast" (transformer) for the pole; such asserted "gain" or point of distinction over *Calso* is like that discussed by this Court (in comparing a *Glencoe* prior device with the Graham patent device):

> "Furthermore, even though the position of the shank and hinge plate appears reversed in Glencoe, the mechanical operation is identical * * * and 'presents no operative mechanical distinctions, much less nonobvious differences." *Graham v. John Deere Co.*, 383 U. S. 1, 26 (1966).

The Issue of Infringement.

Petitioners allege in "Question" (1) an admission of infringement, but the fact is that respondents, through their witness Baldwin and otherwise throughout this case, denied that Guggemos patent claim 11 is properly readable on respondents' accused device, since, if so read, it reads on the prior art Calso device. The Court of Appeals took the same view and position, holding that, in order to avoid a holding of invalidity of the Guggemos patent claims—(if literally interpreted) the Court would interpret the claims to the points of difference between the Guggemos patent specification disclosure over the prior art. Thus the Court of Appeals interpreted the claims as covering the alleged invention made by Guggemos and, so interpreted, as not infringed by respondents' accused device.

Respondents' denial of infringement is stated three times in the pre-trial stipulation (24a):

(1) "It is stipulated between the parties that:" * * * "Defendants have counterclaimed for a decree declaring that the Plaintiffs' patent is invalid and has not been infringed by the Defendants". (24a)

(2) "ISSUES OF LAW" * * * (B-2) "whether the claims in suit are properly readable on and cover the defendants' devices in suit;". (47a)

(3) "And the matters of law for determination of this Court, viz., " * * * "2. Whether the claims in suit are properly readable on and cover the defendants' devices in suit." (49a)

Respondents' expert, Baldwin, pointed out (441a) there is no wording in claim 11 which could possibly distinguish it from the Calso device.

Respondents, throughout the trial and appeal, argued that the Guggemos claims are not infringed in view of the anticipating Calso device, and in their brief on appeal to the Court of Appeals said: "Claims 11, 12 and 14 of the Guggemos patent in suit, are, as a matter of law, invalid for obviousness and not infringed in view of the Calso prior use" etc. and "The judgment for plaintiffs should be reversed and the case remanded for entry of judgment that claims 11, 12 and 14 of the Guggemos patent in suit are invalid and not infringed."

Petitioners' professed expert on infringement, C. O. Grannis (appearing in P-41, p. 1b *infra*) admitted, under examination by respondents' attorney (85a) that (a) he had not examined the file wrapper of the Guggemos patent in suit (b) had not examined the file wrapper references, and (c) had not previously testified in any patent litigation; his testimony as an infringement expert was objected to (89a and 91a and 241a).

Petitioners cite the trial Judge's charge to the jury on claim 11 as an "admission" of infringement; that charge was given by the trial Judge after rejecting (673a-674a) respondents' requests to charge, Nos. 1, 1a, 1b, 1c and 2 (674a-676a), requiring the jury to make specific findings as to the Calso device in relation to the claims in suit.

The trial Court, in the present case, instructed the jury (552a-553a) that the respondents (defendants) deny infringement:

> "The defendants say no. Number one, even if everything you said was true we have not infringed your patent because we do not have every part or element recited in your claim in our accused device.
>
> "They say not only that, but you did not invent anything."

The Court herein charged the jury (567a):

> "In interpreting Claims 11, 12, 14, in reference to the language of the claims, in the limitation, in the interpretation or construction in reference to the prior patents, publications or uses, that any such interpretation should also be applied for the purpose of deciding the question of infringement."

The Court of Appeals in the present case noted (Petitioners' Appendix A-18, 166 USPQ 454, 458) that:

> "In a situation 'requiring appropriate application of standards of law to facts largely undisputed, * * * [there is] no necessity for remand' even where a court reverses an issue usually regarded as one of fact."

That is the rule stated by this Court in *A & P Tea Co. v. Supermarket Corp.*, 340 U. S. 147, 153 (1950): "The questions of general importance considered here are not contingent upon resolving conflicting testimony for the facts are little in dispute." To the same effect:

> "Furthermore upon the undisputed evidence the question of infringement resolves itself in each case into one of law, depending upon a comparison between the structure disclosed on the face of the patent and the device shown in the Dent latch, and the correct application thereto of the rule of equivalency." *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 36 (1929).

The Court of Appeals pointed out differences between respondents' accused device and the Guggemos' claims in suit "given the narrow construction we must apply to the patent" (Petitioners' Appendix A-20 and 166 USPQ 454, 459) and that:

> "As a consequence of the required narrowness of the claims, we find as a matter of law that the accused device is not substantially identical to the patent."

That is the rule stated by this Court:

> "To us, the limited claims of the Scoggin patent are clearly evident from the prior art as it stood at the time of the invention." *Graham v. John Deere Co.*, 383 U. S. 1, 36.

CONCLUSION.

It is respectfully submitted that the "issues" in the petition are old points, fully briefed and argued, considered, and adjudicated by the Court of Appeals in accordance with this Court's rulings, and that the petition should be denied.

Respectfully submitted,

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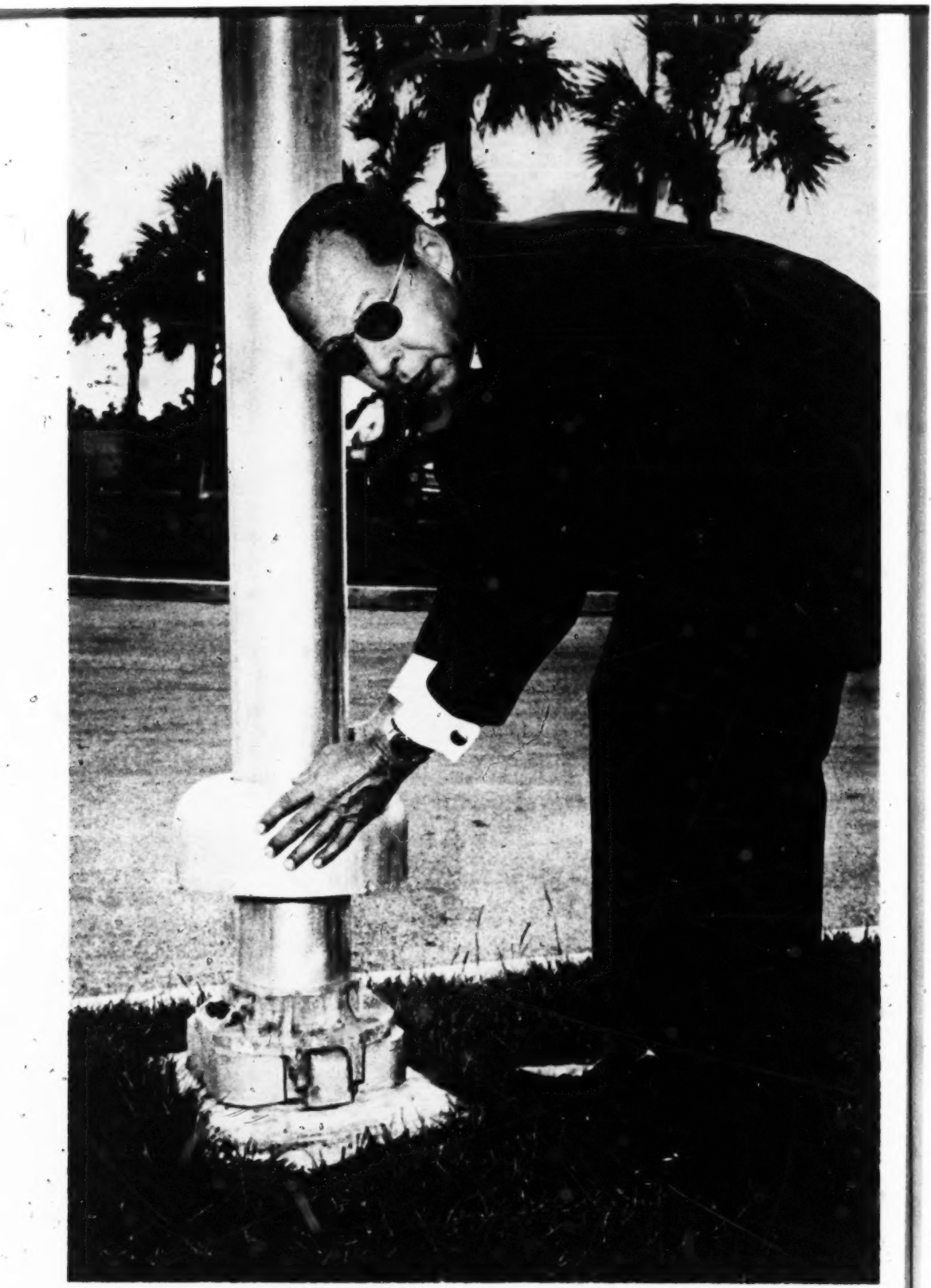

Photo of Respondents accused device shown in elevated or closed position. (Ex. P-41)

Photo of prior art Calso device. (Ex. D-9a)